

### **REMARKS**

The Applicants thank the Examiner for the careful consideration of this application. The Office Action dated October 9, 2009 has been received and its contents carefully considered. Claims 1, and 3-18 are currently pending in this application. Claims 1, 12, 17, and 18 have been amended. Based on the foregoing amendments and the following remarks, the Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

#### **Final Rejection – Premature**

Applicants object to the Examiner's improper rejection of claims under multiple references. It is unclear what rejections are being presented. In the final office action, the Examiner has presented a rejection based upon Brehmer et al., Goldberg, **or** British Shoe Machinery Ltd., in view of Gaku et al., Oien, **or** Lees et al. with Reith as evidence. It is unclear which references are being applied against which claims. The MPEP 707.07(d) clearly states, "A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." In the present case, it is unclear which references are being applied against which claims, and quite clear that all the claims have been improperly grouped together.

It is unclear whether one rejection is being presented or nine. Applicants have not been given sufficient information to respond to the Examiner's rejection. It is unclear what references are being applied against which claims, and what information is being relied upon from which references for the rejection. Applicants have repeatedly requested clarification of this rejection, but none has been provided. This has delayed prosecution, reduced efficiency and increased costs for the Applicants and the Office. Applicants request that the finality of the rejection be withdrawn and that the rejection be properly set forth and clarified.

To advance prosecution, Applicants have filed a Request for Continued Examination. Applicants respectfully request that if an Office Action is issued, that it be non-final, and clearly present the rejections being made, under which references, as required by the MPEP.

### **Specification**

On page 2, the Examiner objects to the specification, specifically to Table 1 as "confusing" since the Examiner is uncertain of the meaning of yes/no. Applicants respectfully point out that the present application describes several embodiments of the invention. The yes/no indication for Example 8 is based on different embodiments of the invention and depends on which of the described embodiments is considered. For example, the material is within the scope of embodiments where the MVR value is between 2 and 6 cm<sup>3</sup>/10 min, and thus the "yes" answer applies, , while the material is outside the scope of embodiments where the MVR value is between 3 and 5 cm<sup>3</sup>/10 min, the material is not suitable, and thus the "no" answer applies. Hence yes/no. The present claims require MVR value is between 2 and 6 cm<sup>3</sup>/10 min. **Clearly**, Example 2 is unsuitable according to the invention **as currently claimed** since the MVR value is greater than 6. The yes/no designation is readily understood by persons in the art and Applicants respectfully request withdrawal of the objection.

### **Claim Rejection – 35 U.S.C. § 112**

On page 2, the Office Action rejects claims 12, 17, and 18 under 35 U.S.C. § 112, second paragraph, as being dependent from a canceled claim. Claims 12, 17 and 18 have been amended to depend from claim 1. Applicants request the rejections be withdrawn.

### **Claim Rejection - 35 U.S.C. §103(a)**

On pages 2-3, the Examiner rejects claims 1 and 3-18 under 35 U.S.C. §103(a) as allegedly unpatentable in view of a combination of Brehmer et al., Goldberg, **or** British Shoe Machinery Ltd., in view of Gaku et al., Oien, **or** Lees et al. with Reith as evidence. As discussed previously, it is unclear which references are being applied to which claims, and which references are being used in combination for which claims. Applicants will, again, attempt to respond based on our best understanding, but request the Examiner clarify exactly what references are being applied to which claims, and in what combinations.

Among other things, the Examiner is comparing two different compositions in the art to the single composition of the invention. On the one hand, the Examiner states that Goldberg and

British Shoe Machinery do not require fabric and may be recyclable without fabric. However, without fabric, the claim limitations are not met, as described below. On the other hand, the Examiner asserts that, when fabric is present, the claim limitations may be met. As previously described, when fabric is present, the materials from the references are not recyclable. The Examiner can not have it both ways – the reference materials with and without fabric are two different materials, neither of which alone renders the invention obvious. Rather than showing obviousness of the presently claimed invention, the Examiner's own position makes it clear that the references do not disclose a material as presently claimed. Accordingly, as explained further below, the rejections should be withdrawn.

On page 3, the Examiner states that the rejections are maintained in view of the "Response to Arguments." In the Response, the Examiner states that the compositions of Goldberg and British Shoe Machinery (hereinafter BSM) are applied to fabric, and that the compositions of Goldberg and BSM are recyclable, only the articles produced after being applied to fabric are non-recyclable.

Applicants point out that the compositions of Goldberg applied to fabric are 35-50% water, and 15-35% of a latex forming polymer. These compositions do not have the required amounts of materials required by claim 1 (i.e. 50-95% of hot-melt adhesive). Even after the water is removed, and the fabric is "saturated with an amount of the latex formulation" (see column 4, lines 7-8) the compositions still lack the amounts of materials required by claim 1. As acknowledged by the Examiner, these articles are not recyclable, and there is no reason to modify the latex compositions of Goldberg to separate them from the fabric. In contrast, the articles of claim 1 (thermoplastic reinforcing material) are recyclable, because they have properties that allow the articles to be formed without a backing.

Likewise, BSM compositions are applied only to a fabric or paper backing. The materials described do not form articles useable separately from the fabric or paper backing. The articles, as acknowledged by the Examiner, are not recyclable. In contrast, articles of the present claims, having the properties described, are produced without fabric or paper backing, and are recyclable. This feature is unexpected in view of BSM. Furthermore, BSM describes materials used for splinting and casting. There is therefore no reason to modify the compositions of BSM for the production of shoe support materials.

The Examiner states "the intended use is immaterial." However, the intended use is material when showing an unexpected result, such as the ability to use the materials as shoe supports without a fabric backing, or the recyclability of the articles, since they require no fabric backing. Applicants are not required to claim the unexpected property, only show that the unexpected property exists with respect to the references cited.

The Examiner states "the connection between Example 7 and Brehmer et al. is not understood." In Applicants' reply of July 20, 2009, a comparison was made between Example 7 from the specification, and the compositions of Brehmer et al. The comparison was made in response to the interview of May 12, 2009, where the Examiner requested a comparison between the Applicants' claims and a composition of Brehmer et al. using chalk or wood fiber as filler. The comparison showed that a composition using chalk or wood fiber as filler does not necessarily produce the claimed properties, and that the rejections based on Brehmer et al. should be withdrawn since they do not have the claimed properties. As stated in the reply of July 20, 2009, it is the **combination** of materials and properties in the claimed materials which determine its suitability in the invention. There is no reason, based on Brehmer et al. to modify their materials to produce Applicants' claimed materials.

The Examiner concludes, "[i]f applicants' compositions as described in claim 1 do not necessarily have all the properties needed for successfully practicing the invention, then it is applicants' task to define the inventive composition such a way [sic] that one of ordinary skill in the art could practice applicants' invention without undue experimentation." The Examiner here appears to apply a new argument not previously presented, a further reason for finality to be withdrawn. The compositions described in claim 1 must have the claimed properties. Applicants have chosen to define the claimed thermoplastic reinforcing materials as made from a combination of polymers and fillers, in specific amounts, where the final articles (thermoplastic reinforcing materials) have particular properties. Claiming in this manner is proper. By definition, materials without the claimed properties are outside the scope of the claims. The determination of the properties is routine in the art, based on standardized processes given in the claims; no "undue experimentation" is required. One of ordinary skill would have no difficulty in determining which

articles and compositions meet the claim requirements and those which do not. Accordingly, the Examiner's remarks are immaterial.

### **Conclusion**

Applicants request reconsideration based on above response. Applicants further request that if an Office Action is issued, the Action be non-final, and any rejections be clearly presented in terms of which references are being applied to which claims, and how each reference is being applied, so that Applicants may fully respond.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

The Commissioner is authorized to charge any deficiency in any patent application processing fees pursuant to 37 CFR § 1.17, including extension of time fees pursuant to 37 CFR § 1.17(a)-(d), associated with this communication and to credit any excess payment to Deposit Account No. 22-0261.

Dated: January 8, 2010

Respectfully submitted,

By           /Keith G. Haddaway/            
Keith G. Haddaway, Ph.D.  
Registration No.: 46,180  
VENABLE LLP  
P.O. Box 34385  
Washington, DC 20043-9998  
(202) 344-4000  
(202) 344-8300 (Fax)  
Attorney/Agent For Applicant